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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,403	01/23/2004	Stephen M. Key	PA2644US	9494
22830	7590	05/09/2006	EXAMINER	
CARR & FERRELL LLP 2200 GENG ROAD PALO ALTO, CA 94303			OSELE, MARK A	
			ART UNIT	PAPER NUMBER

1734

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,403

Applicant(s)

KEY, STEPHEN M.

Examiner

Mark A. Osele

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6,9-12,14-19,21,23-28,30-32 and 34-38 is/are allowed.
- 6) ☒ Claim(s) 7,8,13,20,22,29,33 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03272006
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 7, 20, 33, and 39 rejected under 35 U.S.C. 103(a) as being unpatentable over Jespersen in view of Coulthard. Jespersen teaches that it is known to label a cylindrical object with a rotatable label comprising a base affixed directly to the container and a shell having a rotatable portion with a transparent window and top and bottom guide rails separated from the rotatable portion by severable lines of perforation. The top and bottom guide rails are glued to the container and the consumer breaks the lines of perforation to allow rotation of the rotatable portion which affords a view of indicia on the base layer or container itself (column 1, lines 11-31). Jespersen shows the instantly claimed limitations except for an electrostatic charge to the outer label.

Coulthard teaches that the outer, removable layer in a multi-layer display system can be adhered to the inner layer by an electrostatic charge (column 3, lines 11-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to bond the outer label of Jespersen to the inner layer using an electrostatic charge because Coulthard teaches that this allows for easy removal and replacement of an outer indicia bearing layer.

3. Claims 8, 13, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jespersen in view of Brombacher. Jespersen teaches that it is known to label a cylindrical object with a rotatable label comprising a base affixed directly to the container and a shell having a rotatable portion with a transparent window and top and bottom guide rails separated from the rotatable portion by severable lines of perforation. The top and bottom guide rails are glued to the container and the consumer breaks the lines of perforation to allow rotation of the rotatable portion which affords a view of indicia on the base layer or container itself (column 1, lines 11-31). Jespersen shows the instantly claimed limitations except for adhesive between the two labels.

Brombacher teaches that three glue dots between the layers of a multi-layer label system allow for repeated removal and replacement of the outer layer from the inner layer (column 3, line 62 to column 4, line 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the plurality of glue dots of Brombacher to hold the outer label of Jespersen to the inner label because Brombacher teaches that a consumer can easily remove and replace an outer label using this adhesive. Furthermore, it would have been obvious to one of ordinary skill in the art that the adhesive could be applied to either the inside of the outer layer or the outside of the inner layer because both accomplish adhesive between the layers.

4. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jespersen in view of Morgan and Brombacher. Jespersen teaches that it is known to

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label a cylindrical object with a rotatable label comprising a base affixed directly to the container and a shell having a rotatable portion with a transparent window and top and bottom guide rails separated from the rotatable portion by severable lines of perforation. The top and bottom guide rails are glued to the container and the consumer breaks the lines of perforation to allow rotation of the rotatable portion which affords a view of indicia on the base layer or container itself (column 1, lines 11-31). Jespersen shows the instantly claimed limitations except for a trailing end of the outer label overlaps a leading end of the outer label.

Morgan teaches that the trailing end of the outer label overlaps an adhesive coated leading end of the outer label (column 2, lines 32-47). It would have been obvious to one of ordinary skill in the art at the time the invention was made to bond the leading and trailing ends of the label of Jespersen because Morgan teaches that an outer label sealed this way can be easily removed.

Brombacher teaches that three glue dots between the layers of a multi-layer label system allow for repeated removal and replacement of the outer layer from the inner layer (column 3, line 62 to column 4, line 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the plurality of glue dots of Brombacher to hold the outer label of the references as combined to the inner label because Brombacher teaches that a consumer can easily remove and replace an outer label using this adhesive. Furthermore, it would have been obvious to one of ordinary skill in the art that the adhesive could be applied to either the inside of the outer

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layer or the outside of the inner layer because both accomplish adhesive between the layers.

Response to Arguments

5. Applicant's arguments filed December 22, 2005 have been fully considered but they are not persuasive. Applicant first argues that Jespersen is only concerned with labels that are coupled with a perforation line. The examiner points to column 1, lines 15-16 of Jespersen, "the shell typically is fixed to the base using connective elements, for example, adhesives or perforations."

Applicant also argues that the removal of the electrostatic charge from Coulthard will cause the strips to fall off the display. Electrostatic charges are not removed from articles. Articles cling to each other through electrostatic charges based upon the composition and surface smoothness of the articles (see column 3, lines 46-51). Articles attached to each other through electrostatic charges can be disassembled and readhered repeatedly.

In response to applicant's argument that Coulthard is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Coulthard and the applicant are each concerned with the particular problem of

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temporarily applying a cover sheet to a substrate wherein the cover sheet has a window for visual transmission of information from the substrate therethrough.

Regarding applicant's argument that the resealing taught by Brombacher defeats the purpose of Jespersen's temporary coupling mechanism, it is noted that the resealing of Brombacher does not defeat the purpose of Jespersen, but rather adds an additional option to the invention of Jespersen. By incorporating resealable adhesive dots to the outer label of Jespersen, the outer label of Jespersen can be rotated until selected indicia is seen through the window and resealed into position to prevent inadvertent movement of the outer label which would undesirably cover the selected indicia. It is again noted that Jespersen discloses that both perforations and adhesives can be used to temporarily fix the outer label to the inner label.

The submission of the terminal disclaimer on December 22, 2005 has overcome the double patenting rejection. That rejection has now been removed.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MARK A. OSELE
PRIMARY EXAMINER

May 4, 2006